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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/679,749 | 10/06/2003 | Geoffrey Flagstad | 14969US01 | 2813 |
| 23446 | 7590 | 02/09/2006 | | |
| MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661 | | | EXAMINER TOMASZEWSKI, MICHAEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/679,749 | Applicant(s) FLAGSTAD, GEOFFREY | |
| | Examiner Mike Tomaszewski | Art Unit 3626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 23 November 2005.

Claim 1-64 remain pending. Claims 50-64 are newly added.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 50-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Segal (US 2001/0041991; hereinafter Segal).

(A) As per newly presented claim 50, Segal discloses the method of claim 1, wherein said medical record is made by the covered entity before said inducing (Segal: par. [0121]).

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(B) As per newly presented claim 51, Segal discloses the method of claim 1, wherein said inducing occurs before the patient obtains possession of the medical record (Segal: par. [0024], [0027] and [0121]).

(C) As per newly presented claim 52, Segal discloses the method of claim 1, wherein the patient obtains possession of the medical record before said acquiring (Segal: par. [0121]).

(D) As per newly presented claim 53, Segal discloses the method of claim 1, wherein the patient has a computer with Internet access, and said inducing further comprises inducing said patient to obtain possession in said patient's computer of said medical record in digital form from a covered entity (Segal: par. [0024], [0026], [0027] and [0108], fig. 1).

(E) As per newly presented claim 54, Segal discloses the method of claim 1, further comprising inducing said patient to acquire said medical record in a digital storage format without intervention of any entity or person other than said covered entity (Segal: par. [0024], [0026], [0027] and [0108], fig. 1).

(F) Newly presented claims 55-64 substantially repeat the same limitations as those recited in claims 50-54 and are therefore, rejected for the same reasons given for those claims above.

NOTE: A discussion on how the Examiner has construed the terms "inducing" and "possession" in light of the applied references can be found in section 6 or Response to Arguments, *infra*.

Response to Arguments

6. Applicant's arguments filed 23 November 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 23 November 2005.

(A) On pages 11-12 of the 23 November 2005 response, Applicant argues that Segal does not teach "inducing said patient to obtain possession of a medical record of said patient from a covered entity."

In response, Examiner respectfully submits that Applicant fails to consider the full teachings of Segal. Examiner further submits that Segal does teach "inducing said patient to obtain possession of a medical record of said patient from a covered entity."

For example, Segal teaches that the physician (i.e., covered entity) directs and guides (i.e., induces) the patient to include specific medical information (i.e., medical record), originally omitted by the patient, within their master medical record (Segal: par. [0024] and [0027]). Moreover, Segal teaches that medical information includes an array of records including, but not limited to, scanned documents such as EKGs and medical

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images such as x-rays (Segal: par. [0023]). As such, the physician, upon determining that the patient has excluded certain x-ray imagery from their master medical record, would necessarily need to induce a patient to obtain possession of their x-ray imagery from a covered entity (i.e., medical office or hospital where the patient has been treated, which maintain records of that treatment) so that it could be delivered to the appropriate medical personnel for scanning and included within the patient's master medical record (Segal: fig. 4, 6 and 7a-7e; par. [0121]; Examiner considers x-ray imaging to be a procedure done exclusively by medical professionals rather than by the patient and therefore, a patient would need to be induced to undergo x-ray imaging and/or obtain possession of their x-ray images in order to complete the patient's master medical record. Furthermore, because Segal teaches that medical personnel scan a patient's medical imagery, rather than the patient, the patient would need to be induced to deliver their medical images to the medical personnel for scanning.).

Examiner also respectfully submits that the concept of a covered entity inducing a patient to obtain possession of their medical records is notoriously well known and obvious as a standard operating procedure of medical facilities—this is particularly evident during the initial registration process of a new patient requesting medical services from a medical facility for the first time and when a patient is seeking a second opinion medical diagnosis so that the medical facility can establish the patient's medical history.

Lastly, Examiner considers the claim language “inducing said patient to obtain possession of a medical record of said patient from a covered entity” to include

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indirect/constructive inducement (e.g., medical facilities) and self-inducement (e.g., brought about by the patient himself or herself). As such, Examiner does not consider the term "induced" to be limited to inducement "caused by someone else" as Applicant has suggested.

(B) On page 12 of the 23 November 2005 response, Applicant argues that Segal does not indicate the records are obtained from a covered entity.

In response, Examiner respectfully submits that this argument has been addressed in section 6.A., *supra*, of the present Office Action.

(C) On page 12 of the 23 November 2005 response, Applicant argues that Segal does not teach that the "service provider" is providing a medical record to the patient.

In response, Examiner respectfully submits that this argument has been addressed in section 6.A., *supra*, of the present Office Action.

(D) On page 13 of the 23 November 2005 response, Applicant argues that Segal does not disclose that "other parties interested in acquiring a medical record from a patient would be required to induce the patient to obtain their [the patient's] medical records for them [other parties]."

In response, Examiner respectfully submits that this argument has been addressed in section 6.A., *supra*, of the present Office Action.

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(E) On page 13 of the 23 November 2005 response, Applicant argues that “the term ‘induce’ introduces a time element” and that “if the patient already possesses the record, one can no longer induce the patient to obtain possession of the record.”

In response, Examiner respectfully submits that this argument has been addressed in section 6.A., *supra*, of the present Office Action.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., possession) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Nevertheless, in *arguendo*, Examiner notes that the term “possession” can be broadly defined as having a degree of access and control over something. As such, a patient could be considered to have had possession of a medical record from the moment of the medical record's inception because even if a covered entity created the medical record and maintained custodial control of the medical record, access and control of the medical record ultimately resided with the patient all along anyway—therefore, there would have never been a need to induce the patient to obtain possession of their medical record to begin with.

(F) On page 14 of the 23 November 2005 response, Applicant argues that Mok fails to show “inducing said patient to convert said medical record into a storage format.”

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In response, Examiner respectfully submits that this argument is immaterial because Segal teaches "inducing said patient to convert said medical record into a storage format" (Segal: abstract; par. [0151]).

(G) On page 15 of the 23 November 2005 response, Applicant argues that Judson fails to show either inducing step.

In response, Examiner respectfully submits that this argument has been addressed in sections 6.A. through 6.F., *supra*, of the present Office Action.

(H) On page 15 of the 23 November 2005 response, Applicant argues that the present invention is not obvious in view of any combination of the applied references, absent hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Moreover, Examiner respectfully submits that this argument has been addressed in sections 6.A. through 6.F., *supra*, of the present Office Action.

(l) On page 15 of the 23 November 2005 response, Applicant argues that the references do not mention or suggest HIPAA requirements, much less teach a way to obtain records free of such requirements.

In response to applicant's arguments, the recitation of HIPAA requirements has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches an identification bracelet with electronic information (5,883,576); a method and apparatus for a personal health network (5,827,180); an information record infrastructure, system and method (US 2002/0010679); and a system and method for automated creation of patient controlled records (US 2002/0026332).

The cited but not applied prior art also includes non-patent literature articles by Weiss, Ray ("Patients gain access, privacy" Apr 14, 2003. News Journal. pg. 07.C.) and Hoppszallern, Suzanna ("HIPAA: The patient privacy challenge" Dec 2002. Hospitals & Health Networks. Vol. 76, Iss. 12. pg. 38.).

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT

1.30.06


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER